

11-14-06

Docket No: AM100257
Patent

215
TW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re of Application of: **KAUP et al.**
Application No.: **10/681,658** Group No.: **1651**
Filed: **October 8, 2003** Examiner: **Irene Marx**
For: **NUTRITIONAL FORMULATIONS CONTAINING SYNBIOTIC
SUBSTANCES**
Confirmation No.: **7271**
Customer Number: **25291**

DIRECTOR OF TECHNOLOGY CENTER 1600
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450

PETITION UNDER 37 C.F.R. 1.181

Sir:

Applicants hereby petition for relief from the decision of the Examiner to make final the Office Action dated July 19, 2006 in the above-identified application, for the reasons set forth below.

In the Office Action dated July 19, 2006, the Examiner introduced a new ground for rejection based on a reference not previously cited, Luchansky, et al. (U. S. Pat. No. 5,902,743). The Examiner erroneously stated that this rejection was necessitated by the Applicants amendments in response to the prior Office Action, and made the rejection final.

In response to this final Office Action, Applicants filed an Amendment on October 16, 2006 which included amendments and arguments to overcome the new rejection, and which stated in part:

The Examiner has made the present Office Action final, on the basis that Applicants' amendment necessitated the new grounds for rejection. Applicants respectfully disagree.

CERTIFICATE OF MAILING 37 CFR §1.10

I hereby certify that this paper and the documents referred to as enclosed therein are being deposited with the United States Postal Service on the date written below in an envelope as "Express Mail Post Office to Addressee" Mailing Label Number **EV 100497755 US** addressed to Director of Technology Center 1600, United States Patent and Trademark Office, PO Box 1450, Alexandria, VA 22313-1450.

November 13, 2006
Date

M. Cecilia Chessell
M. Cecilia Chessell

Under present practice, second or any subsequent actions on the merits shall be final except where the Examiner introduces a new ground for rejection that is not necessitated by Applicants' amendment or by a new information disclosure statement (MPEP, 706.07(a), August 2005). In this case, the new grounds for rejection based on Luchansky, et al. were not necessitated by the Applicants' prior amendment. For example, although the amendment of claim 1 to narrow the subject matter from a nutritional composition comprising certain ingredients to an infant formula comprising the same ingredients may have prompted the Examiner to search for another reference, the Examiner could and should have found and cited this reference against the original claims in the first action on the merits, particularly since the specification is clearly directed to an infant formula. A reference that is material to an infant formula claim is certainly at least as material to a nutritional composition claim where the elements are identical, since nutritional compositions include infant formulas.

By not citing this reference until a second and final action, the Examiner deprives Applicants of the full and fair hearing to which Applicants are entitled. Applicants believe that the finality of the present Office Action is premature, and respectfully request withdrawal thereof.

The Examiner replied to this Amendment with an Advisory Action dated October 30, 2006 which advised Applicants that no amendments were entered and that Applicants arguments were not found persuasive because they were directed to claims not entered. Despite Applicants clear request for withdrawal of the finality of the Action, the Advisory Action failed to address the issue whether it was proper to make the Office Action final.

The result of the Examiner's actions is that a reference which should have been cited and could have been applied against the original claims was not cited or applied until the second Office Action, and the Applicants were given no opportunity to amend the claims to overcome the new ground for rejection.

In a case such as this where the Examiner fails to discover or apply a reference which could have been applied in the first Office Action, the Examiner is required to give the Applicants an opportunity to respond to the new ground for rejection, including the opportunity to amend and to receive a full and fair hearing on the new ground. It is not appropriate in such a second action to make the new rejection final. MPEP 706.07(a) clearly states that, "Under present practice, second or an subsequent actions on the merits shall be final, except where the examiner introduces a new ground for rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement..."(emphasis added).

A new ground for rejection is not necessitated by an amendment of the claims merely because an Examiner feels motivated to look for another reference once Applicants have overcome a prior rejection. Where, as here, the new ground for rejection could have been applied to the claims prior to amendment, it was not necessitated by the amendment.

Applicants cannot receive the full and fair hearing to which they are entitled if an Examiner may wait until the second amendment to cite the closest prior art and immediately make the new rejection final.

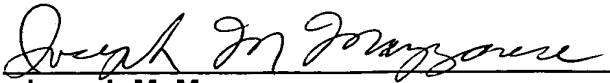
MPEP 706.07 states, "Before final rejection is in order a clear issue should be developed between the examiner and the applicant. [T]he invention as disclosed and claimed should be thoroughly searched in the first action and the references fully applied..." (emphasis added). The Examiner has failed to follow this procedure.

The Examiner clearly has failed to follow the procedures of the Office, and has not provided Applicants with the full and fair hearing to which they are entitled.

For all the foregoing reasons, Applicants respectfully request a prompt decision on this petition to:

- 1) withdraw the finality of the Office Action dated July 19, 2006;
- 2) reopen prosecution on the merits;
- 3) enter of the amendments provided in the Amendment filed October 16, 2006; and,
- 4) give due consideration to the arguments and amendments filed on October 16, 2006.

No fee is believed to be due herewith, but should a fee be required please charge it to Deposit Acct. No. 01-1425.


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